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Appln. No.: 10/691,715
Amendment dated July 10, 2007
Reply to Office Action of April 17, 2007

REMARKS/ARGUMENTS

The Office Action of April 17, 2007, has been carefully reviewed and these remarks are responsive thereto. Claims 10-25, 27, and 31 have been amended, claims 1-9 have been canceled without prejudice or disclaimer, and new claims 32 and 33 have been added. Claims 10-33 thus remain pending in this application. Reconsideration and allowance of the instant application are respectfully requested.

Amendments to the Specification

Applicants have amended the specification to cure minor informalities and an administrative error consisting of the apparent omission of page 22 during filing of the application. No new matter has been added. The amended specification describes what is clearly shown in Figures 15-18. Support for the present amendment can at least be found in Figures 15-18 and at paragraph [0050], as well as throughout the specification as would be understood by one of ordinary skill in the art.

New Claims

Applicants have added new claims 32 and 33. Support for the new claims can be found at least at paragraphs [0065] and [0066] in the application specification originally filed. No new matter has been added.

Rejections Under 35 U.S.C. § 101

Claim 31 stands rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter because the means to perform the function is software. Applicants respectfully traverse this rejection for at least the following reasons.

A system claim that contains means-plus-function elements and is supported by structural description in the specification is patentable subject material. *See In re Alappat*, 33 F.3d 1526, 31 USPQ2d 1545 (Fed. Cir. 1994). In finding statutory subject matter in an apparatus claim containing means-plus-function claiming, the *Alappat* Court required the PTO to interpret 35 U.S.C. 112 6th paragraph, for 35 U.S.C. 101 purposes in the same fashion as *In re Donaldson*. *In re Alappat*, 33 F.3d 1526, 31 USPQ2d 1545 (Fed. Cir. 1994); *See In re Donaldson*, 16 F.3d 1189, 29 USPQ2d

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1845 (Fed. Cir. 1994) (finding the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination). Therefore, the *Alappat* Court found such a claim patentable subject matter because “the claimed invention as a whole is directed to a combination of interrelated elements which combine to form a machine [that performs the desired function] to be displayed on a display means.” *In re Alappat*, F.3d at 1557. Further, the Court held that a digital computer, once programmed, becomes a special purpose computer, a machine specially configured to perform certain tasks, and as such, is statutory subject matter. *Id.* at 1545.

Applicant's specification makes reference to a machine structure. Fig. 19 and 20 disclose an exemplary mobile telephone and computer architecture that can be programmed to employ the invention's novel aspects. *See also* Applicant's Specification, paragraphs [0091] – [0107]. Additionally, paragraph [0100] of Applicant's Specification enumerates a plurality of other computer system configurations that one skilled in the art can program to employ the inventive system. Moreover, the enumerated single or multiprocessor computer systems can be programmed such that the claimed means-plus-function elements are combined to form a machine performing the inventive process to be displayed to a user; thus, satisfying the standard in *In re Alappat*, which finds system claims with means-plus-function elements patentable subject matter. Applicants therefore request the rejection be withdrawn.

Claim Objections

Claim 9 is objected to because of improper grammar. Claim 9 has been canceled, rendering the objection moot.

Examiner's Note

The examiner notes that 35 U.S.C. 112 6th paragraph has not been invoked by the means-plus-function language in claim 31 because, “while the claim passes the first test of the three-prong test used to determine invocation of paragraph 6, since no other specific structural limitations are disclosed in the specification, the claims do not meet the other tests of the three-prong test.”

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Applicant respectfully disagrees with the examiner and contends that 35 U.S.C. 112 6th paragraph has been invoked by the means-plus-function language of claim 31. A claim limitation will be presumed to invoke 35 U.S.C. 112 6th paragraph, if it meets the following 3-prong analysis: (a) the claim limitations must use the phrase "means for" or "step for;" (b) the "means for" or "step for" must be modified by functional language; and (c) the phrase "means for" or "step for" must not be modified by sufficient structure, material, or acts for achieving the specified function.

While Applicant's claim, as the Office Action states, clearly satisfies the first prong of the test, it also satisfies the other two prongs. The second prong is satisfied when the elements in the claim are set forth, at least in part, by the function it performs as opposed to the specific structure, material, or acts that perform the function. *See York Prod. Inc. v. Central Tractor Farm & Family Center*, 99 F.3d 1568, 1574, 40 USPQ2d 1619, 1624 (Fed. Cir. 1996). Applicant contends that all "means for" elements within claim 31 are modified by the function they perform in a sufficient manner; thus, rendering the second prong satisfied.

The test's third prong is satisfied *unless* the means-plus-function language is modified or contains sufficient structure or acts for performing the specified function. *See Seal-Flex v. Athletic Track*, 172 F.3d 826, 849, 50 USPQ2d 1225, 1234 (Fed. Cir. 1999) (Rader, J., concurring). Applicant contends that the third prong is satisfied because the claim elements do not impart nor are they modified by structure or acts within the claim itself for performing the specified function.

Rejections Under 35 U.S.C. § 102

Claims 1-4, 6-8, 27 and 29 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. No. 6,940,532, hereinafter Fukui. Applicants respectfully traverse.

Claims 1-4 and 6-8 have been canceled, rendering the rejection moot with respect to these claims. With respect to claims 27 and 29, in order to reject a claim as anticipated under 35 U.S.C. §102, a single prior art reference must teach every aspect of the claimed invention. MPEP § 706.02.

Independent claim 27 has been amended to recite, among other things, "selecting a graphical indicator on a scroll bar, said graphical indicator associated with a point of focus;" and

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“changing the location of the point of focus based on user input moving the graphical indicator on the scroll bar.”

Thus, amended claim 27 is not anticipated by Fukui. Fukui describes a system where “marks” allow the display to be automatically reset to the mark’s location at the completion or cancellation of a scrolling function. *See, e.g.*, (Column 4, Line 48 – Column 5, Line 52.) Fukui does not describe generating or mapping graphical indicia to a scroll bar, nor does it describe changing the location of the point of focus based on user input moving the graphical indicator on the scroll bar, as claimed. Given that Fukui does not describe all the features as recited in claim 27, claim 27 is allowable for at least these reasons.

Dependent claim 29, which depends from claim 27, is allowable for at least the same reasons as claim 27.

Rejections Under 35 U.S.C. § 103

Claims 5, 9-18, 20-25, 30 and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable Fukui in view of U.S. Pat. No. 6,778,192, hereinafter Arbab.

Claims 5 and 9 have been canceled without prejudice or disclaimer, rendering the rejection moot with respect to these claims.

Claim 16 has been amended in independent form such that the recitations of canceled claim 9 have been merged into claim 16. Claim 16 now recites, among other things, “wherein the system is configured for a user to change the location of the item of interest by moving the graphical indicator.” The Office Action at pages 6-7 contends that Fukui teaches this feature and cites Column 8, lines 16-20 as addressing this feature specifically. However, the cited portion only describes that the marks may be deleted when the file is closed or when a new mark is set in a state where a mark is present; Fukui does not teach or suggest wherein the system is configured for a user to change the location of the item of interest by moving the graphical indicator, as claimed.

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Further, Fukui's marks are not the same as Applicant's graphical indicators. The Office Action admits "Fukui does not explicitly disclose...a component that obtains a location of the user-identified item of interest, *generates a graphical indicator for the item of interest and maps the graphical indicator to the scroll bar to provide the user with a visible indication of the location of the item of interest within the info.*" (Office Action dated April 17, 2007, page 7) (emphasis added). Thus, Applicant respectfully disagrees with the Office Action's later characterization that Fukui teaches this limitation and contends a system that does not generate graphical indicia mapped to scroll bars also does not teach or suggest the ability for a user to move the location of the item of interest by moving a graphical indicator.

Additionally, neither Fukui or Arbab, or any combination thereof, teaches or suggests such a feature. Fukui describes a system where "marks" allow the display to be automatically reset to the mark's location at the completion or cancellation of a scrolling function. *See, e.g.,* (Column 4, Line 48 – Column 5, Line 52.) Fukui does not teach or suggest generating or mapping graphical indicia to a scroll bar. Arbab describes a system that creates graphical markers on scroll bars that reference locations of interest within a file. *See, e.g.,* (Column 2, Lines 25-30). However, the graphical markers in Arbab only serve as visual reference points on the scroll bars. While Arbab may describe the automatic or user-input *creation* of graphical markers at locations of an item of interest, Arbab does not teach or suggest that these graphical markers could be *moved* by the user to *change* the location of the item of interest. (Column 4, Lines 9-38.)

Given that neither Fukui, Arbab, nor any combination thereof teach or suggest all of the features as recited in claim 16, claim 16 is allowable for at least these reasons.

Independent claims 23 and 31 recite features similar to those discussed above with respect to claim 16, and are thus allowable for at least the same reasons as claim 16.

Dependent claims 10-15, 17-18, 20-22, 24-25, and 30, which each depend from at least one of claims 16, 23, or 27, are allowable for at least the same reasons as their respective base claims.

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Claim 19 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukui in view of Arbab, and further in view of U.S. Pat. No. 6,331,866, hereinafter Eisenberg.

Eisenberg fails to cure the above noted deficiencies of Fukui and Arbab. Dependent claim 19, which depends from at claim 16, is therefore allowable for at least the same reasons as claim 16, and further in view of the additional features recited therein.

Claims 26 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukui in view of Arbab, and further in view of U.S. Pat. No. 6,778,192, hereinafter MacPhail.

MacPhail fails to cure the above noted deficiencies of Fukui and Arbab. Dependent claims 26 and 28, which depend from at least one of claims 23 or 27, are therefore allowable for at least the same reasons as their respective base claims, and further in view of the additional features recited therein.

CONCLUSION

All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the Examiner is requested to contact the undersigned at (202) 824-3153.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated this 10th day of July, 2007

By: /Ross Dannenberg/
Ross Dannenberg, Registration No. 49,024
1001 G Street, N.W.
Washington, D.C. 20001-4597
Tel: (202) 824-3000
Fax: (202) 824-3001

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